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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,246	08/20/2003	Gary Hochman	0813-017P/JAB	6059

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SCHWEITZER CORNMAN GROSS & BONDELL LLP  
292 MADISON AVENUE - 19th FLOOR  
NEW YORK, NY 10017

EXAMINER
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EBRAHIMI DEHKORD, SAEID

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/644,246	Applicant(s) HOCHMAN, GARY	
	Examiner Saeid Ebrahimi-dehKordy	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.                                                |

### DETAILED ACTION

1. Examiner acknowledges that applicant has filed a Terminal Disclaimer to over come the double patenting rejection, However the latest search has found that Hughes-Hartogs would clearly teach the present invention.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-18 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Hughes-Hartogs (U.S. patent 5,657,381)

**Regarding claims 1 and 10** Hughes-Hartogs discloses: discloses: A method for the transmission of image data from a sender (note Figs.2&3, column 5 lines 7, where the MUXs 31 and 31 with the computers 41 and 42) to a recipient (note Fig.2 and 3, items 62,64 and 66 column 5 lines 8-9) comprising the steps of:

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inserting at the location of the sender into a data transmission including an image format portion data identifying the address of the intended recipient of the image-format portion of the transmission (note column 5, lines 9-14, where the format is changed to be acceptable to the recipient) and message tracking data (note column 7 lines 2-8 where the accounting information is tagged at the sending devices 62-66, lines 6-8) transmitting the data transmission over a transmission system from the sender's location to an intermediate point of presence facility (note column Figs. 2,3 and 4 item 50 the Fax server or in this case the point of presence facility, column 5 lines 15) and receiving the data transmission by the point of presence facility and re-transmitting the data comprising the image portion to the identified address of the recipient (note column 5 lines 15-27 where the Fax server 50 would reformat and compile the accounting information and re-transmit the data to the recipients addresses or Faxes).

**Regarding claim 2 and 14** Hughes-Hartogs discloses: The method of claim 1 wherein the message tracking data inserted comprises at least one of accounting, audit and documentation data (note column 7 lines 5-8).

**Regarding claim 3** Hughes-Hartogs discloses: the method of claim 2 further including the step of processing the message tracking data by the point of presence facility (note column 5 lines 15-27, where the point of presence is in this case the Fax server 50).

**Regarding claim 4** Hughes-Hartogs discloses: The method of claim 3 including the further step of stripping the message tracking data from the data transmission at the point of presence facility before retransmission (note column 5 lines, 17-19 where the accounting information is compiled and considered).

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**Regarding claim 5** Hughes-Hartogs discloses: The method of claim 1 further including the steps of: inserting at the location of the sender into the data transmission data identifying an address of the sender; and sending a confirmation message to the sender's address by the point of presence facility after re-transmitting the data comprising the image portion to the recipient's identified address (note column 5 lines 28-43 where the Fax document is emailed to the recipient).

**Regarding claim 6 and 7** Hughes-Hartogs discloses: the method of claim 1, wherein the address of the recipient is an email address and the step of retransmitting the data includes forwarding the data in the form of an email attachment to the recipient email address (note again column 5 lines 28-43).

**Regarding claim 8** Hughes-Hartogs discloses: The method of claim 6, wherein the address of the sender is an e-mail address and the step of sending a confirmation message includes forwarding an e-mail message to the sender's e-mail address (note column 5 lines 35-43).

**Regarding claim 11** Hughes-Hartogs discloses: The method of claim 10 wherein the identified address of the recipient is a telephone number associated with a facsimile reception apparatus and said re-transmission includes a portion over a telephone line linked to the facsimile reception apparatus (note column 4 lines 1-20).

**Regarding claim 12** Hughes-Hartogs discloses: The method of claim 10 wherein the transmission from the sender to the point of presence Facility is in the form of an e-mail transmission (note column 5 lines 35-43).

**Regarding claim 13** Hughes-Hartogs discloses: The method of claim 1 wherein the step of transmitting the data transmission over a telephone system from the sender's location to an

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intermediate point of presence facility include converting the image data to facsimile format and transmitting the image data in the facsimile format (note column 5 lines 5-27).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes-Hartogs (U.S. patent 5,657,381) in view of Henrick (U.S. patent 6,151,137)

**Regarding claim 9** Hughes-Hartogs does not clearly disclose: The method of claim 1 further including the steps of generating a confirmation message by the point of presence Facility after re-transmitting the data comprising the image Portion to the recipient's identified address and allowing the sender access to the confirmation message. On the other hand Henrick discloses: The method of claim 1 further including the steps of generating a confirmation message by the point of presence Facility after re-transmitting the data comprising the image Portion to the recipient's identified address and allowing the sender access to the confirmation message (note column 5 lines 32-44 where the confirmation message is sent to the sender regarding the re-transmission of the facsimile data). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Hughes-Hartogs's invention according to the teaching of Henrick, Where Henrick in the same field of endeavor teaches the way the confirmation report as the status of the received facsimile would be transmitted before the

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connection would be terminated, this would increase the capability of the whole facsimile system.

### **Claim Objections**

1. Claims 6 and 7 are objected to because of the following informalities: the claims 6 and 7 are duplicate claims. Appropriate correction is required.

### **Contact Information**

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeid Ebrahimi-Dehkordy whose telephone number is (571) 272-7462.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(571) 273-8300, (for **formal** communications; please mark  
**"EXPEDITED PROCEDURE"**)

**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
**"PROPOSED"** or **"DRAFT"**)

**Hand delivered responses** should be brought to Knox building on 501 Dulany Street, Alexandria, VA.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy  
Patent Examiner  
Group Art Unit 2625  
January 5, 2007

A handwritten signature in black ink, appearing to read 'Saeid Ebrahimi-Dehkordy', is written over the printed name and title.